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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,129	02/13/2004	Sikun Lan	CITI0286-US	3809

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KING & SPALDING LLP (CITI CUSTOMER NUMBER)  
ATTN: GEORGE T. MARCOU  
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WASHINGTON, DC 20006

EXAMINER
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CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
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2436

MAIL DATE	DELIVERY MODE
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01/04/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/777,129	<b>Applicant(s)</b> LAN ET AL.	
	<b>Examiner</b> David García Cervetti	<b>Art Unit</b> 2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's amendments filed 10/1 and 11/3/2009 have been fully considered.
2. Claims 1-19 are pending and have been examined. Claims 20-40 have been canceled.

### ***Response to Amendment***

3. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection.
4. The applicant has not adequately traversed the examiner's use of official notice with regards to the claimed limitations found in claims 3-5, 8, and 15-19, these features are taken by the examiner to be admitted prior art since the applicant has not adequately challenged the examiner's use of official notice (see MPEP 2144.03(c), 2144.04).

### ***Information Disclosure Statement***

5. **It is noted that no information disclosure statement has been filed on this application to date.**

### ***Continued Examination Under 37 CFR 1.114***

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Claim(s) 1-19 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The method including steps of ... is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**11. Claims 1-2, 6-7, and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein (US 6,023,510), and further in view of Pollitt (US 2003/0069803).**

**Regarding claim 1, Epstein teaches**

a method for providing a secure response to a first party (abstract), comprising the steps of:

receiving a first submission from the first party over a communications network, wherein the first submission is directed to a second party and includes an identifier associated with the first submission, and wherein the first party is not authenticated or registered with the second party (col.5, lines 1-22, user formulates query Q, user remains anonymous);

receiving a response to the first submission from the second party (col.5, lines 28-67, service provider responds to user, posts response with associated identifying information);

storing the response for later retrieval by the first party or the second party (col.3, lines 14-30, board stores responses);

receiving a second submission from the first party wherein the second submission comprises information for correlation to the identifier provided in the first submission; authenticating the first party (col.5, lines 27-35, user accesses board and downloads response using the generated random number as identifying info).

Epstein does not expressly disclose, however, Pollitt teaches sending a notification to the first party, wherein the notification provides information for securely accessing the response; and permitting the first party to securely access the response from the second party, wherein the first party cannot access the stored response until the first party is authenticated via the notification to the first party (par.358-364, email with link and authentication information).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to send an email with a link to access the secure response. One of ordinary skill in the art would have been motivated to perform such a modification to provide remote access to stored information (Pollitt, par.6-21).

**Regarding claim 2**, the combination of Epstein and Pollitt teaches wherein the communications network is the Internet (Epstein, col.5, lines 35-67).

**Regarding claim 6**, the combination of Epstein and Pollitt teaches wherein the first party is a user at a client system (Epstein, col.5, lines 1-67).

**Regarding claim 7**, the combination of Epstein and Pollitt teaches wherein the user is a prospect (Epstein, col.5, lines 1-67).

**Regarding claim 9**, the combination of Epstein and Pollitt teaches wherein the submission from the first party is forms-based (Epstein, col.5, lines 1-67).

**Regarding claim 10**, the combination of Epstein and Pollitt teaches wherein the submission from the first party contains private information about the first party (Epstein, col.5, lines 1-67).

**Regarding claim 11**, the combination of Epstein and Pollitt teaches wherein the submission from the first party is received through a secure system (Epstein, col.5, lines 1-67).

**Regarding claim 12**, the combination of Epstein and Pollitt teaches wherein the second party includes a customer service representative (Epstein, col.5, lines 1-67).

**Regarding claim 13**, the combination of Epstein and Pollitt teaches wherein the response to the submission contains private information about the first party (Epstein, col.5, lines 1-67).

**Regarding claim 14**, the combination of Epstein and Pollitt teaches wherein the notification is an unsecured email notification (Pollitt, par.358-364).

**12. Claims 3-5, 8, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein and Pollitt, and further in view of Admission.**

**Regarding claims 3-5**, the combination of Epstein and Pollitt does not expressly disclose wherein the identifier is a password / username/ or email address, however these features have been admitted per applicant to have been conventional and well known at the time the invention was made.

**Regarding claim 8**, the combination of Epstein and Pollitt does not expressly disclose wherein the first party pre-registered with the second party prior to the submission by the first party, however these features have been admitted per applicant to have been conventional and well known at the time the invention was made.

**Regarding claims 15-19**, the combination of Epstein and Pollitt does not expressly disclose the claimed features, however these features have been admitted per applicant to have been conventional and well known at the time the invention was made.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID CERVETTI whose telephone number is (571)272-5861. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David García Cervetti/  
Primary Examiner, Art Unit 2436